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In re Application of :
MATHIESON et al. :
Application No.: 09/701,062 : DECISION ON PETITION
PCT No.: PCT/AU099/00382 :
Int. Filing Date: 20 May 1999 :
Priority Date: 20 May 1998 :
Attorney Docket No.: 102055-0049 :
For: CABLE CONNECTION DEVICE AND
METHOD

This is in response to applicants' "Alternative Petitions to Withdraw Holding of Abandonment Based on Failure to Receive Office Action and Based Unintentional Abandonment (MPEP 711.03(c))" filed 26 December 2001, requesting that the United States Patent and Trademark Office withdraw the abandonment under 37 CFR 1.181, or in the alternative a petition to revive the application under 37 CFR 1.137(b).

BACKGROUND

On 20 May 1999, applicants filed international application No. PCT/AU099/00382 which claimed a priority date of 20 May 1998, and which designated the United States. A Demand, electing the U.S., was filed with the International Preliminary Examining Authority prior to the expiration of 19 months from the priority date. As a result, the deadline for entry into the national stage in the U.S. expired 30 months from the priority date, on 20 November 2000.

On 20 November 2000, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia: the basic national fee; a copy of the international application; and a preliminary amendment.

On 13 December 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that oath or declaration executed by the inventor and the \$130.00 surcharge for filing after the thirty-month period were required. The notification set a ONE (1) MONTH period for response.

On 26 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT UNDER 35 U.S.C. 371 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 13 December 2000 within the

time period set therein.

On 26 December 2001, applicants filed the present "Alternative Petitions to Withdraw Holding of Abandonment Based on Failure to Receive Office Action and Based Unintentional Abandonment (MPEP 711.03(c))" accompanied by: an executed declaration; the docket record for application no. 09/701,062; and the docket record for application no. 09/402,143.

DISCUSSION

Petition Under 37 CFR 1.181

With regards to applicant's request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

With regard to Item (1), practitioner states that, "that he and his firm never received the aforesaid Notice of Missing Requirements."

With regard to item (2) above, practitioner has not affirmatively attested that a search of the file jacket and docket records indicates that the Notification of Missing Requirements was not received.

As to Item (3), applicants have provided a copy of the docket record which purportedly shows where the paper would have been entered had it been received. The printout of the docket report for this specific application or comparable docket record for another application is not sufficient to establish that the Notification of Missing Requirements was not received and mis-docketed for another application. Accordingly, applicants are required to provide docket records for all communications received at practitioner's office having a due date of 13 January 2001.

Thus, applicants have not provided the proper showing necessary to withdraw the holding of abandonment and the petition may not be properly granted.

Petition to Revive Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the submission of the declaration.

As to Item (2), the appropriate petition fee of \$1280.00 as required by 37 CFR 1.17(m) has been charged to Deposit Account No. 03-1237.

With regard to Item (3), applicants' statement that "entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

Deposit Account No.03-1237 has been charged a \$130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date, as authorized.

CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice.

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The application has an international filing date of 20May 1999 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **26 December 2001**.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.



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